



GP 3208
#10/dpr
8/26/96
Petition
re 1.181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
)
Stan Hockerson) Art Unit: 3208
)
Serial No.: 08/400,336) Examiner: T. Kavanaugh
)
Filed: March 8, 1995)
)
For: INDEPENDENT IMPACT SUSPENSION)
ATHLETIC SHOE)
_____)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on August 9, 1996.
Richard E. Backus, Reg. No. 22,701

Signed: RE Backus Date: 8/9/96

PETITION TO THE COMMISSIONER -- RULE 1.181

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Applicant, through his undersigned attorney, hereby petitions the Commissioner under Rule 1.181(a)(3) to exercise supervisory authority to:

1. direct that the Office Action dated April 26, 1996 was premature and that the Examiner improperly refused, in the Advisory Action date August 2, 1996, to enter applicant's Amendment and Response to Office Action that was submitted on July 23, 1996;
2. direct that the Declaration of Stan Hockerson submitted with said Amendment

260 01 06-1300 08/15/96 08400336
26038 122 130.00CH

and Response to Office Action on July 23, 1996 was timely filed and that the declaration should be accepted and given consideration.

Please debit any fees for this Petition to Deposit Account #06-1300 (Order No. A-59987-2/REB).

STATEMENT OF FACTS

1. In the first Office Action dated November 13, 1995 the prior art grounds of rejection for the claims were:

- Claims 1-4 were rejected under section 103 as unpatentable over the Hunt '832 patent in view of the Ellis '491 patent.
- Claims 1-4 were further rejected under section 103 as unpatentable over applicant's own Hockerson '895 patent in view of the Ellis '491 patent.

2. Applicant's Amendment and Response to Office Action dated March 14, 1996 responded to the first Office Action with certain amendments to independent claim 1. The amendments included the provision in claim 1 of a lasting board. In the Remarks section of the response applicant's urged patentability of the amended claims and explained how the amended claims defined over the references cited in that Office Action. Applicant pointed out that the provision of the lasting board which was added by amendment to claim 1 distinguished over the combination of references.

3. Next the final Office Action was made on April 26, 1996 in which the substantive claim rejections were:

- Claims 1-4 were rejected under section 103 as unpatentable over the Clarke '963 patent in view of the Miller '851 patent. The Examiner cited Miller as teaching a lasting board mounted within the upper and above the sole of a shoe, and asserted

that it would have been obvious to provide the shoe of Clarke with a lasting board as taught by Miller. The examiner further contended that with "the height between the channel and the upper (the connecting portion) appears to be sufficiently small to present minimal transfer of motion between the compression elements responsive to stress force." This statement referred to the height between the channel and the upper of the Clarke reference because the preceding paragraph of the Office Action referred to the Clarke reference having such a channel.

4. On July 23, 1996 applicant filed his Amendment and Response to Office Action under Rule 1.116 to place the application in condition for allowance or in better form for consideration on appeal. In that amendment independent claim 1 was amended: a) to correct certain indefinite language responsive to the section 112 rejection, and b) to include limitations for defining over the Clarke reference including a limitation that the heel portion comprises a midsole and an outsole carried below the midsole, that the longitudinal channel is formed in and divides the midsole and outsole into the laterally adjacent compression elements, and that the channel extends upwardly through the sole and is separated from the upper by a connecting portion which has a vertical height that is effective to present a minimal transfer of motion between the compression elements responsive to stress forces. The inclusion in claim 1 of the limitation regarding the sole comprising a midsole and outsole and with the longitudinal channel extending upwardly through both the midsole and outsole was for defining over the Clarke reference which, as explained at pp. 3-4 of applicant's amendment, had a sole in which a shallow channel was formed in only the outer sole and did not extend upwardly into the midsole.

5. Submitted with applicant's Rule 1.116 amendment was the Declaration of

Stan Hockerson. That declaration was submitted under Rule 1.132 for purposes of traversing the rejection over the Clarke reference, as specifically noted in applicant's Remarks at p. 4: "The accompanying Declaration of Stan Hockerson explains the results of forces that would act on a shoe constructed in accordance with the Clarke patent during and following the heel strike phase. . . . " The Hockerson declarations presented and explained certain factual data and charts resulting from actual tests on a motion analysis machines of various individuals running with prior art shoes, running with shoes incorporating applicant's invention and running barefoot.

6. In the Advisory Action dated August 2, 1996 it was stated that applicant's Rule 1.116 amendment was not entered and that the final rejection stands on grounds that the proposed amendment raises new issues that would require further consideration and/or search. In addition, the declaration of Stan Hockerson was indicated as not being timely filed under MPEP §715.09.

POINTS AND AUTHORITIES

Applicant requests the Commissioner to exercise supervisory authority under Rule 1.181 in the following respects:

1. The Finality of the Office Action Dated April 26, 1996 Should Be Withdrawn and Applicant's Amendment Dated July 23, 1996 Be Entered

A final rejection is proper on a second office action except where "the Examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record." MPEP §706.07(a). The question of a final rejection being premature is reviewable by petition under Rule 1.181. MPEP §707.07(c). Applicant in the Amendment and Response to

Office Action dated July 23, 1996 made a timely request for reconsideration of the final rejection, but the Examiner continued the final rejection in the Advisory Action of August 2, 1996.

In the Office Action of April 26, 1996 it was stated at p. 4 that the action was made final because applicant's amendment necessitated the new grounds of rejection. However, as set forth above in ¶2 of the Statement of Facts, the only substantive amendment to the claims in applicant's first Amendment and Response to Office Action was to add the limitation of the lasting board so as to distinguish over the section 103 Ellis in view of Hunt ground of rejection. Yet in the final Office Action there was a new ground of rejection because, in addition to citing the Miller reference as showing a lasting board, the Examiner cited, for the first time, Clarke as the principal reference rather than Ellis. While Clarke had previously been in the case as art of record it had not cited in the first Office Action. Under MPEP §706.07(a) the fact that Clarke was already of record is not a consideration.

The Clarke patent was not cited or applied in the final Office Action due to any of the amendments made in applicant's response of April 14, 1996. At page 3 of the Office Action the Examiner cited Clarke as disclosing an athletic shoe having a longitudinal channel in the bottom surface of the sole with the channel extending through the peripheral rim and dividing the heel portion into a pair of laterally adjacent compression elements. Clarke was not, and could not have been, applied for teaching the lasting board feature which was added in applicant's first amendment. The Miller patent was applied solely for that purpose.

Clearly, therefore, the Office Action of April 26, 1996 was prematurely made final because the applicant's use of Clarke as the primary reference constituted a new ground

of rejection which was in no way necessitated by applicant's first amendment. To uphold the finality of the rejection based on Clarke would mean that applicant has not been given a fair opportunity to respond to that ground of rejection. The finality of the action is improper under the rules of procedure and should be withdrawn.

2. The Declaration of Stan Hockerson Should Be Considered Timely Submitted and Be Given Consideration

In the Advisory Action it was indicated that the Declaration of Stan Hockerson was not timely filed, reference being made by the Examiner to MPEP §715.09. It is respectfully submitted that applicant's Declaration of Stan Hockerson must be considered as timely submitted because it was presented to traverse the new ground of rejection based on Clarke in view of Miller. MPEP §715.09 specifically provides that "... other evidence traversing rejections are considered timely if: . . . (c) submitted after final rejection and submitted (i) with a first response after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection" The Clarke in view of Miller combination of references must be considered a new ground of rejection for the reasons set forth in the preceding section of this Petition.

ACTION REQUESTED

In view of the foregoing the Commissioner is respectfully requested to invoke supervisory authority under Rule 1.181 and:

1. Declare the finality of the Office Action of April 26, 1996 as premature and withdrawn, and direct that applicant's Amendment and Response to Office Action dated July 23, 1996 be entered and given consideration by the Examiner;
2. Direct that applicant's Declaration of Stan Hockerson submitted with the

Amendment on July 23, 1996 be considered as timely filed and given consideration by the Examiner.

Respectfully submitted,

Date: 8/9/96

RE Backus
Richard E. Backus
Reg. No. 22,701

FLEHR, HOHBACH, TEST
ALBRITTON & HERBERT
Four Embarcadero Center, Suite 3400
San Francisco, CA 94111
(415) 781-1989